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Horst M Kasper
13 Forest Drive
Warren, NJ 07059

EXAMINER

MEINECKE DIAZ, SUSANNA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3623

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--|--|
| Office Action Summary | Application No. 09/659,428 | Applicant(s) VERMA ET AL. ST | |
| | Examiner Susanna M. Diaz | Art Unit 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004 and 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19, 21, 23 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☒ Claim(s) 11-16, 18, 19, 21, 23 and 28-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Final Office action is responsive to Applicant's amendment filed August 6, 2004.

Claims 15, 17, 28, 30, and 31 have been amended.

Claims 34-44 have been added.

Claims 11-19, 21, 23, and 28-44 are pending.

2. The previously pending objections to the specification are withdrawn in response to Applicant's amendment of the specification.

The previously pending claim objections are withdrawn in response to Applicant's amendment of the claims.

The previously pending rejections under 35 U.S.C. § 112, 1st and 2nd paragraphs
are withdrawn in response to Applicant's amendment of the claims.

Response to Arguments

3. In Applicant's response filed on July 26, 2004, Applicant states:

Applicant notes the detailed reasoning in the Office Action. Applicant so far did not find a good answer to the arguments and considerations of the Office Action. Applicant is continuing with efforts to avoid the rejections expressed and intends to supplement the present Response. (Pages 25-26 of Applicant's response filed July 26, 2004)

In the supplemental response filed on August 6, 2004, Applicant presented no additional arguments. Therefore, there are no arguments to address at this time.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 43 recites that access is provided to at least one of the plurality of databases through an input and output interface through e-mail, voice telephony or video telephony. However, independent claim 40 (from which claim 43 depends) recites access to the databases via the World Wide Web through a browser. The specification states, "The input and output interfaces to the apparatus are provided via the World Wide Web, Email, voice telephony, or video telephony" (page 5 of the specification). The specification, as originally filed, does not disclose the use of the World Wide Web simultaneously with e-mail, voice telephony or video telephony to provide input and output interfaces, as is recited in claim 43. Therefore, claim 43 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 42 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 42, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 43 recites that access is provided to at least one of the plurality of databases through an input and output interface through e-mail, voice telephony or video telephony. However, independent claim 40 (from which claim 43 depends) recites access to the databases via the World Wide Web through a browser. The specification states, "The input and output interfaces to the apparatus are provided via the World Wide Web, Email, voice telephony, or video telephony" (page 5 of the specification). The specification, as originally filed, does not disclose the use of the World Wide Web simultaneously with e-mail, voice telephony or video telephony to provide input and output interfaces, as is recited in claim 43. Therefore, it is not clear how the claimed invention can utilize both the World Wide Web along with e-mail, voice telephony or video telephony at the same time to provide input and output interfaces, as is recited in claim 43.

Appropriate correction is required.

In light of the rejections of claim 43 under 35 U.S.C. § 112, 1st and 2nd paragraphs, prior art will not be applied to claim 43 at present.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-16, 18, 19, 21, 23, 28-42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziff-Davis' NetBuyer, as disclosed in "Ziff-Davis Signs Up 189 Advertisers for the Coming Launch of Its Computer Shopper NetBuyer Web Site" (herein referred to as Ziff-Davis) and "Nothing But Net: Useful Internet Sites," in view of NetDynamics, as disclosed in "Service Merchandise Uses NetDynamics to Move Its Entire Catalog Onto the Internet" (herein referred to as NetDynamics).

NetBuyer discloses a method for presenting a price comparison to a prospective buyer comprising:

[Claim 11] collecting information from a plurality of merchants that comprises data on said products including price (Ziff-Davis: ¶¶ 3, 12; "Nothing But Net: Useful Internet Sites": ¶ 17);

storing said data into at least one of a plurality of databases (Ziff-Davis: ¶¶ 3, 12; "Nothing But Net: Useful Internet Sites": ¶ 17);

sorting the information relative to products based on the database (Ziff-Davis: ¶¶ 3, 12; "Nothing But Net: Useful Internet Sites": ¶ 17);

presenting the information in a plurality of records to the prospective buyer (Ziff-Davis: ¶¶ 3, 12; “Nothing But Net: Useful Internet Sites”: ¶ 17);

[Claim 13] entering data for merchants offering a specific product into the database, wherein the data includes merchant name, product description, sales price, product description, sales price, coupons or rebates (Ziff-Davis: ¶¶ 3, 6, 7, 12);

providing access to the database through a browser interface (Ziff-Davis: ¶¶ 3 -- “web-based”).

As per claim 11, NetBuyer does not explicitly teach that merchant products compared and presented to customers on the Internet can be ordered online and picked up from a local store; however, NetDynamics makes up for this deficiency.

NetDynamics provides the following services through their affiliates:

Included with the expanded catalog are NetDynamics applications enabling customers to check to see if a product they want is available at their local Service Merchandise store. Customers will be able to reserve the item online before visiting the store to pick it up...

Rinat explained that all of this is made possible because NetDynamics enables the development of Web applications that tie into extensive data sources. In the case of Service Merchandise, these data sources include product listings, price, and availability. NetDynamics enables Service Merchandise customers to access this information over the Internet and then to purchase it through a secure transaction. (¶¶ 6, 8)

Both NetBuyer and NetDynamics are concerned with providing a convenient Internet shopping experience to the customers; NetDynamics takes this concept one step further and fulfills many customers’ need for immediate gratification (i.e., the ability

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to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the step of collecting information from a plurality of merchants relating to data concerning products in store locations and respective price information, wherein the prospective buyer is capable of visiting the store locations, with NetBuyer's Internet shopping system in order to reap the benefits of NetBuyer's product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

As per claims 11-13, the NetBuyer-NetDynamics combination teaches the concept of comparing desired products from different merchants via the Internet, ordering products online, and then picking up the products at a local merchant (as discussed above). In order for such a system to be operational, a customer must specify his/her location so that stores truly local to the customer can be identified. The Examiner submits that the use of a state to identify one's location (thereby implying one's local region) is old and well-known in the art; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to request that a prospective buyer specify a state in which a desired product will be searched for and then picked-up, if available, as part of the NetBuyer-NetDynamics combination in order to allow a prospective buyer to quickly learn if desired products are available for pick-up locally (instead of forcing the prospective buyer to read through useless product inventory data from stores in remotely located states). Further, the notion of sorting a

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database by sales price was addressed above as well; therefore, the concept of presenting products in an ascending order based on sales price (as part of the NetBuyer-NetDynamics combination) would also have been obvious to one of ordinary skill in the art at the time of Applicant's invention in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs). Finally, as discussed above, the concept of sorting data provides a convenience to someone reviewing the sorted data; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to allow a prospective buyer to sort product data as seen fit by the buyer (e.g., based on price, merchant name, etc.) as part of the NetBuyer-NetDynamics combination in order to facilitate a quicker review of only the most pertinent products fitting the buyer's needs.

Regarding claim 12, NetBuyer conveys the importance of allowing customers to search for products that meet the individual needs of each customer (Ziff-Davis: ¶¶ 3, 4); however, NetBuyer does not expressly disclose the sorting of its product database by price. The Examiner asserts that price is often a factor taken into account when customers shop for products that meet their needs; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to sort NetBuyer's product database according to price in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs). Furthermore, NetBuyer does not expressly teach that product information is gathered from sales

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circulars, such as those that are inserted into newspapers as advertisements; however, Official Notice is taken that it is old and well-known in the art of advertising to publish product and sales data from one's sales circular on the Internet as well. This makes sales data more easily accessible not only to those who rely on postal mail to learn of sales, but also to those who make a habit of surfing the Internet. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to encourage NetBuyer's vendors to submit product and sales information that is consistent with that publicized in their sales circulars in order to make the sales data more easily accessible not only to those who rely on postal mail to learn of sales, but also to those who make a habit of surfing the Internet.

Regarding claim 14, NetBuyer does not explicitly disclose the use of a unique address corresponding to a geographical area-product pair combination; however, the

Examiner asserts that the assignment of a unique web address corresponding to a particular geographical region is old and well-known in the art. This technique is helpful in reducing Internet traffic at a given web site. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to map the merchant and product data (of the NetBuyer-NetDynamics combination) to a unique address and present comparison data for a unique geographical area-product pair to the prospective buyer via this unique address in order to minimize Internet traffic build-up at a given web site. This will speed up each prospective buyer's Internet connection, thereby providing a more pleasant online shopping experience.

In reference to claim 15 and as discussed above, NetDynamics teaches the steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed. Again, this shopping arrangement provides for the fulfillment of many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed with NetBuyer's Internet shopping system in order to reap the benefits of NetBuyer's product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

Regarding claim 16, both NetBuyer and NetDynamics facilitate the payment of an ordered product via the Internet; however, neither reference expressly teaches payment through the use of either a registration token or a credit card number. The Examiner asserts that it is old and well-known in the art to make payments via the Internet using either a registration token or a credit card number; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate the use of a registration token or a credit card number to order and pay for a

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product via the Internet (as part of the NetBuyer-NetDynamics combination) in order to facilitate convenient and secure Internet payments. Further, since the NetBuyer-NetDynamics combination teaches the online reservation of an item before picking it up, the ability to make payment via the Internet provides extra assurance to the merchant that the reserved item will be picked up by a customer. In other words, reserved items are confirmed sales as opposed to items merely put on hold that may or may not ever be picked up and paid for by the customer.

[Claims 18, 19, 21] Claims 18, 19, and 21 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

[Claim 23] Claim 23 recites limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

[Claims 28-33] Claims 28-33 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

Furthermore, as per claims 29, 30, and 32, NetBuyer publicizes specials and weekly deals to its customers ("Nothing But Net: Useful Internet Sites": ¶ 17); however, it does not expressly teach that said specials and weekly deals include the use of coupons or rebates or price protection guarantees. Official Notice is taken that it is old and well-known in the art of shopping to provide customers with coupons, in-store rebates, and price protection with guaranteed return of a price difference if a lower product price is found as incentives to encourage future patronage from customers.

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Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide NetBuyer's customers with coupons, in-store rebates, and price protection with guaranteed return of a price difference if a lower product price is found (as per claims 29, 30, and 32) in order to encourage future patronage from these customers.

As per claim 33, Official Notice is taken that it is old and well-known in the art of advertising to present prospective buyers with a list of top picks of merchants selling a product in order to attract prospective buyers to the best deals available, thereby increasing odds of making a sale. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate with NetBuyer the promotion method of presenting to the prospective buyer a number of top picks of merchants selling the selected product locally in order to attract prospective buyers to the best deals available, thereby increasing odds of making a sale.

[Claims 34-42, 44] Claims 34-42 and 44 recite limitations already addressed by the rejection of claims 11-16 and 28-33 above; therefore, the same rejection applies.

Allowable Subject Matter

10. Claim 17 is allowed.

11. The following is an examiner's statement of reasons for allowance:

The art of record most closely resembling the claimed invention is the combination of the following references:

Ziff-Davis' NetBuyer, as disclosed in "Ziff-Davis Signs Up 189 Advertisers for the Coming Launch of Its Computer Shopper NetBuyer Web Site" and "Nothing But Net: Useful Internet Sites";

NetDynamics, as disclosed in "Service Merchandise Uses NetDynamics to Move Its Entire Catalog Onto the Internet"; and

Various teachings of Official Notice.

While NetBuyer provides the basis for an online shopping system that allows buyers to compare product specifications and prices among vendors and NetDynamics discloses an online shopping system that allows buyers to check the immediate, physical availability of a product in a local store's inventory and the ability to reserve such a product for immediate pick-up at the store, neither NetBuyer nor NetDynamics nor the combination thereof discloses or suggests the combination of these online shopping features with the following combination of features recited in claim 17:

"collecting additional information from sales circulars...

entering geographical region, postal code, town name, county name, state name, product name, product category, model number, product description, price, product features, or brand name into a search key...

entering data for merchants offering a specific product in a specific state into the database, wherein the data includes merchant name, product description, sales price, coupons or rebates...

presenting options to the prospective buyer for choosing a state and a product;
choosing a state and a product by the prospective buyer;
retrieving the data after the state and product are chosen;
sorting records in an ascending order based on sales price into a listing;
presenting the prospective buyer with the listing of merchants offering the product for sale in the chosen state...

mapping the data to a unique address for a geographical area-product combination;
connecting to the unique address;

immediately presenting comparison data for a unique geographical area-product pair to the prospective buyer;

checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product;

reserving the product at the local store for pickup after determining availability has been performed;

entering a registration token or a credit card number;
accepting the registration token or credit card number by the merchant;
guaranteeing a purchase by the merchant based on the accepting of the registration token or credit card number by the merchant."

For this reason, claim 17 is deemed to be allowable over the prior art of record.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

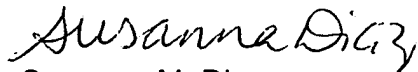
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Primary Examiner
Art Unit 3623
September 15, 2004